



AUG 31 2001

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In re Application of MOULE et al
U.S. Application No.: 09/600,359
Int. Application No.: PCT/GB99/00044
Int. Filing Date: 18 January 1999
Priority Date: 16 January 1998
Attorney Docket No.: 7376-2
For: BARRIER MATERIALS AND PRODUCTS
PRODUCED THEREWITH

COMMUNICATION

This is in response to the papers filed 26 April 2001.

BACKGROUND

On 18 January 1999, applicants filed international application PCT/GB99/00044, which claimed priority of an earlier United Kingdom application filed 16 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 22 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 July 2000 (16 July 2000 was a Sunday).

On 14 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 09 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 26 April 2001, applicants submitted copies of a declaration and an assignment, which were purportedly filed on 20 September 2000. The submission includes a copy of a return postcard which lists the declaration and assignment in its itemized contents and bears a USPTO date stamp of 20 September 2000. In addition, the submission includes a copy of a statement claiming small entity status and a copy of a return postcard which lists the statement claiming small entity status in its itemized contents and bears a USPTO date stamp of 21 September 2000.

DISCUSSION

I. Filing date of declaration, assignment, and statement claiming small entity status

The evidence of record is sufficient to establish that the declaration and assignment were originally filed on 20 September 2000. Specifically, the copy of the return postcard, which includes a "Declaration & Power of Atty." and an "Assignment" in its itemized contents and which bears a USPTO date stamp of 20 September 2000, serves as *prima facie* evidence that the declaration and assignment were received by the USPTO on 20 September 2000.

Furthermore, the evidence of record is sufficient to establish that the statement claiming small entity status was originally filed on 21 September 2000. Specifically, the copy of the return postcard, which includes a "Small Entity Declaration" in its itemized contents and which bears a USPTO date stamp of 21 September 2000, serves as *prima facie* evidence that the statement claiming small entity status was received by the USPTO on 21 September 2000.

II. Request for Refund

37 CFR 1.28(a) states in relevant part,

A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee.

In the present case, the statement claiming small entity status filed on 21 September 2000 is a proper assertion of small entity status under 37 CFR 1.27. The request for refund which accompanied the statement claiming small entity status bears a certificate of mailing which states that the request for refund and small entity statement were mailed on 15 September 2000. Because 15 September 2000 is more than two months after the date of timely payment of the basic national fee and the additional claim fee on 14 July 2000, a refund pursuant to 37 CFR 1.128(a) may not be obtained.

CONCLUSION

For the reasons set forth in §II above, the request for refund is DISMISSED without prejudice.

The application has an International Filing Date of 18 January 1999 and a date under 35 U.S.C. 371 of 20 September 2000.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including according the copies of the declaration and assignment an original filing date of 20 September 2000 and according the copy of the statement claiming small entity status an original filing date of 21 September 2000.



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